

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

Claims 1-18 are pending in this application.

Claims 1-4, and 10 have been amended to incorporate the subject matter of claim 7 into claims 1-4 and to make related formal amendments to claim 10. Claims 7-9 and 13-18 have been canceled without prejudice or disclaimer.

No new matter has been added.

Response to Rejection Under 35 U.S.C. 102

Claim 1 has been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,916,953 (Jacoby). The rejection is traversed. Without acceding to any allegation of the rejection, claim 1 has been amended to incorporate the subject matter of claim 7, which is not included in the rejection. Jacoby does not anticipate claim 1 as amended. Withdrawal of the rejection is requested.

Response to Rejections Under 35 U.S.C. §103

Claims 2-4 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Jacoby. The rejection is traversed. Without acceding to any allegation of the rejection, claims 2-4 have been amended to incorporate the subject matter of claim 7, which is not included in the rejection. Jacoby does not teach all the elements of claims 2-4 as amended and cannot support a prima facie case of obviousness. Withdrawal of the rejection is requested.

Claims 5 and 6 have been rejected under 35 U.S.C. § 103 as allegedly unpatentable over Jacoby in view of U.S. Patent No. 3,595,523 (Felton). The rejection is traversed. Without acceding to any allegation of the rejection, claim 1 has been amended to incorporate the subject matter of claim 7, which is not included in the rejection. Claims 5 and 6 depend from claim 1. The combination of Jacoby and Felton does not teach all the elements of claims 5 and 6 as amended and cannot support a prima facie case of obviousness. Withdrawal of the rejection is requested.

Claims 1-4, 7, 10, 13 and 16 have been rejected under 35 U.S.C. § 103 as allegedly unpatentable over U.S. Patent No. 5,391,665 (Matsunaga). Claims 5, 6, 8, 9, 11, 12, 14, 15, 17 and 18 have been rejected under 35 U.S.C. § 103 as allegedly unpatentable over Matsunaga in view of Felton. The rejections are traversed and treated together to the extent that Matsunaga with or without combination with Felton may be applied to the claims as amended. Without acceding to any allegation of the rejection, claim 1 has been amended to incorporate the subject matter of claim 7 and claims 13-18 have been canceled.

It is first noted that the Examiner has given no patentable weight to the preamble phrase "A resin member, for a valve." While it is recognized that a preamble reciting an intended use may not always provide a patentable distinction, such a finding is only appropriate where the purpose is irrelevant to the structure defined in the body of the claim. A classic example was provided by *In re Casey*, 152 USPQ 235 (C.C.P.A. 1967) in which the intended use of a device as a tape dispenser was not distinguishing over a prior art perforating machine comprising the same structure. This and similar cases show that a preamble may not

be given weight only in those instances where there is no need to consider the preamble to understand the structure of the claimed invention.

That is not the case in the present claims. This case is similar to the classic *Kropa* case in which the court said

In the case before us, the words “An abrasive article” are essential to point out the invention defined by the counts. In our judgment those introductory words give life and meaning to the counts, for it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an “abrasive article.”

Kropa v. Robie, 88 USPQ 478, 480-81 (C.C.P.A. 1951). It is certainly to be recognized that not every piece of epoxy resin is a valve member. The recitation that the present claims are directed to a resin member for a valve is essential to understand that the resin member has the structure of a valve member as distinct from an unformed block of resin.

The recitation that the subject matter of the claims is a resin member for a valve gives life and meaning to the recitation of material in the claim and, as in *Kropa*, is “essential to point out the invention” defined by the claims. *Id.* The preamble provides a distinguishing limitation because “[t]he preamble serves to focus the reader on the invention that is being claimed” as recognized more recently by the Federal Circuit. *See On Demand Machine Corp. v. Ingram Industries Inc.*, 78 USPQ2d 1428 (Fed. Cir. 2006). In that case, the Federal Circuit held “We conclude that the preamble in this case necessarily limits the claims, in that it states the framework of the invention . . .” *Id.*

Therefore, applicants submit that the rejections cannot be sustained unless the prior art can be held to establish a *prima facie* case of obviousness as to the claims as a whole, that is as resin members for a valve comprising the combination of compositional and structural features recited in the claims. Applicants submit that while the Examiner has identified prior art that discloses certain individual components of resin and certain valve members, the prior

art considered as a whole does not render the specifically claimed combination of the present invention obvious.

The claims as amended recite a specific combination of compositional and structural features that would not have been obvious when considered as a whole.

Matsunaga does not teach either the specific combination of elements nor the ratios of those elements that are recited in the claims. Matsunaga does not teach the particular combination in a molding material of a resin composition containing an epoxy acrylate resin (A) having a hydroxyl value of 60 to 100, a polyisocyanate compound (B) having 0.1 to 1.5 isocyanate groups per one hydroxyl group of the epoxy acrylate resin (A), a curing agent (C), an internal mold release agent (D), and 20 to 70% by mass of a fiber reinforcing material (E). Matsunaga does not teach the molding material further comprising 5 to 50 parts by mass of a scaly filler (F) based on 100 parts by mass of the epoxy acrylate resin (A).

Matsunaga does not teach the structural properties required for a resin valve body member that are recited in the claims. Matsunaga does not teach one to make a molding material having a tensile strength of 80 to 400 MPa at normal temperature. Matsunaga does not teach one to make a molding material having a tensile strength of 75 to 350 MPa at 120°C. Matsunaga does not teach one to make a molding material having a tensile strength of 80 to 400 MPa at normal temperature and a notched Izod impact strength of 15 to 100 KJ/m² at -20 to 120°C.

The teachings that the Examiner has identified in Matsunaga are only of the most general nature, listing a panoply of possible resin components which could lead to an almost infinite variety of materials each having unknown specific properties. There is no guidance leading to the combination of features recited in the present claims, let alone a valve member

comprising such a combination of features. Therefore, a person of ordinary skill in the art could not have read Matsunaga and arrived at the present invention.

Felton discloses a butterfly valve of mostly plastic construction. However, Felton does not provide any guidance that would lead a person of ordinary skill in the art to the particular combination that is recited in the present claims. Therefore, the combination of Felton and Matsunaga would not have brought a person of ordinary skill in the art any nearer to the present invention as a whole.

Throughout the Office Action, the Examiner has contended that it is *per se* obvious to select a known material on the basis of its suitability for the intended use. However, that is not sufficient to make out a *prima facie* case of obviousness of the present claims as a whole. Even under a post-*KSR* analysis, “an invention is not obvious to try where vague prior art does not guide an inventor toward a particular solution.” *Bayer Schering Pharma AG v. Barr Laboratories Inc.*, 91 USPQ2d 1569, 1573 (Fed. Cir. 2009).

The Office Action has not adduced any clearly articulated reason to make the claimed invention as a whole. What is required is explicit analysis articulating a reason for combining the particular elements and features recited in the claims. *See KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007) (*citing In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)).

An analysis must explain how a person of ordinary skill would have been led to make the particular invention at issue. The Federal Circuit has noted that “it remains appropriate for a post-*KSR* court considering obviousness ‘to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.’”

Fresenius USA Inc. v. Baxter International Inc., 92 USPQ2d 1163, 1173 (Fed. Cir. 2009) (citing *KSR*, 550 U.S. at 418). Here, there is no evidence adduced in the Office Action, or to be found in the prior art, that there would have been any apparent reason to combine the particular compositional and structural elements recited in the claim to make a valve body member. Therefore, there is not a sufficient basis to maintain a prima facie case of obviousness. Accordingly, withdrawal of the rejection is appropriate and is requested.

CONCLUSION

For at least the foregoing reasons, the all pending rejections should be withdrawn. In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.

In the event that there are any questions relating to this Amendment and reply, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

The Director is hereby authorized to charge any appropriate fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,

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